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In re Application of
MARCHTHALER et al.
Application No.: 10/563,992
PCT No.: PCT/DE04/01628
Int. Filing Date: 22 July 2004
Priority Date: 04 August 2003
Attorney Docket No.: 10191/4331
For: ANTIGLARE SYSTEM FOR A VEHICLE

DECISION ON PETITION TO
REVIVE ABANDONED
APPLICATION UNDER 37 CFR
1.137(b) AND PETITION UNDER
37 CFR 1.497(d) TO CORRECT
INVENTORSHIP

This decision is issued in response to applicants' "Petition For Revival under 1.497(d) or 37 CFR 1.137(b)" filed 10 December 2007.

BACKGROUND

On 22 July 2004, applicants filed international application PCT/DE04/01628 which claimed a priority date of 04 August 2003. The published international application identified four applicant/inventors for the United States: Hans-Dieter Bothe; Hoang Trinh; Heiko Freienstein; and Thomas Engelberg. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 17 February 2005. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 04 February 2006.

On 09 January 2006, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); the international application; and a preliminary amendment.

On 04 May 2006, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 31 May 2006, applicants filed a declaration executed by: Reiner Marchthaler; Hans-Dieter Bothe; Hoang Trinh; Heiko Freienstein; Thomas Engelberg; and Matthias Wellhoefer.

On 16 October 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the declaration filed 31 May 2006 was defective because it indicated additional inventors (Reiner Marchthaler and Matthias Wellhoefer) not listed on the published international application.

On 16 November 2006, applicants filed a "Response to 'Notification of Defective Response' to Missing Requirements under 35 U.S.C. 371."

On 05 January 2007, the Office of PCT Legal Administration mailed "Communication & Notification of Abandonment" indicating that the above-identified application was abandoned for failure to file a proper response to the Notification of Missing Requirements mailed 04 May 2006.

On 26 February 2007, the United States Elected Office mailed a Notification of Abandonment under 37 CFR 1.495 (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 04 May 2006 within the time period set therein.

On 10 December 2007, applicants filed the present petition under 37 CFR 1.137(b) and 37 CFR 1.497(d).

DISCUSSION

1. Petition under 37 CFR 1.137(b)

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional delay must be accompanied by: (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

With respect to item (1), the "required reply" in the present circumstances is a proper response to the Notification Of Missing Requirements mailed 04 May 2006, that is, a declaration in compliance with 37 CFR 1.497 and the required surcharge under 37 CFR 1.492(h). The surcharge under 37 CFR 1.492(h) has been charged to Deposit Account No. 11-0600. The remaining element of the "required reply" is an oath or declaration in compliance with 37 CFR 1.497. In an attempt to satisfy this requirement, applicants have submitted a petition under 37 CFR 1.497(d) requesting to add inventors, Reiner Marchthaler and Matthias Wellhoefer, to the present application. As discussed in detail below, the petition under 37 CFR 1.497(d) is grantable. The declaration submitted on 31 May 2006 is now acceptable under 37 CFR 1.497(a)-(b). Item (1) is therefore satisfied.

With respect to item (2), applicants have submitted the required petition fee. Item (2) is therefore satisfied

With regard to Item (3), applicants' statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

As to Item (4), the terminal disclaimer is not required since this application was filed after 08 June 1995.

Applicants have therefore satisfied all the requirements for a grantable petition under 37 CFR 1.137(b). The Petition For Revival is granted.

2. Petition Under 37 CFR 1.497(d)

Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicants must correct the inventorship pursuant to 37 CFR 1.497(d).

37 CFR 1.497(d) states:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

(1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;

(2) The processing fee set forth in § 1.17; and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees (see § 3.73(b) of this chapter).

(4) any new oath or declaration required by paragraph (f) of this subsection.

Applicants' 10 December 2007 submission satisfies the requirements of 37 CFR 1.497(d). Applicants have submitted statements from both the added inventors in compliance with 37 CFR 1.497(d)(1). The authorization contained in the 10 December 2007 submission will be used to charge Deposit Account No. 11-0600 the \$130 processing fee required under 37 CFR 1.1497(d)(2). And applicant has submitted a statement of consent

by the assignee, along with a copy of the Assignment document by which the assignee obtained its interest in the present application.

Accordingly, applicants have satisfied all the requirements for correction of inventorship under 37 CFR 1.497(d).

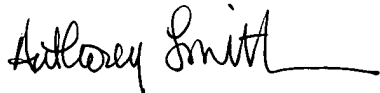
CONCLUSION

Applicants' petition for revival under 37 CFR 1.137(b) is **GRANTED**.

Applicants' request to correct inventorship under 37 CFR 1.497(d) is **GRANTED**.

Reiner Marchthaler and Matthias Wellhoefer have been added as an inventor herein.

This application is being returned to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision. The 35 U.S.C. 371 date is **31 May 2006**.



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